



22 JAN 2008

3M INNOVATIVE PROPERTIES COMPANY
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In re Application of
YOKOYAMA
Application No.: 10/595,093
PCT No.: PCT/US04/26701
Int. Filing Date: 17 August 2004
Priority Date: 22 August 2003
Attorney's Docket No.: 58821US006
For: PRECURSOR PASTE AND METHOD OF :
PRODUCING THE SAME

:
:
: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.47(b)
:
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This is a decision on renewed petition under 37 CFR 1.47(b), filed 27 November 2007 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventor Chikafumi Yokoyama.

BACKGROUND

On 25 September 2006, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b).

On 03 January 2007, a decision dismissing the petition was mailed to applicant indicating that applicant had not met the requirements of 37 CFR 1.47(b).

On 3 April 2007, applicant filed a renewed petition under 37 CFR 1.47(b). On 05 July 2007, a decision dismissing the petition was mailed to applicant.

On 31 July 2007, applicant filed a renewed petition under 37 CFR 1.47(b). On 28 September 2007, a decision dismissing the petition was mailed because Petitioner had not provided proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 27 November 2007, a renewed petition was filed along with a statement under 37 CFR 3.73(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner previously satisfied Items (1), (2), (3), (4) and (6).

With regard to Item (5)¹, Petitioner is attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application. A copy of an agreement entitled "Secrecy Agreement" where the employee (nonsigning inventor) agreed to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment was provided. However, as previously stated, when such agreement is relied upon, a firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant and that all conditions were met is required.

With the renewed petition, Petitioner submitted a second statement of counsel.² Counsel now "declare[s] that I have reviewed the Record of Invention bearing Chikafumi Yokoyama's signature that pertains to the invention described in 58821US006 and that such Record of Invention was received by 3M Innovative Properties Company during Chikafumi Yokoyama's employment by Sumitomo 3M Limited. Therefore, I declare that I have firsthand knowledge that the invention described in 58821US006 was made by Chikafumi Yokoyama during his employment by Sumitomo 3M." Although Counsel makes reference to a Record of Invention (ROI) to conclude that Mr. Yokoyama created the invention while employed by Sumitomo 3M, no such document is attached to her statement.

If counsel is relying on the ROI previously submitted on 3 April 2007, that specific ROI is insufficient as a supporting document for her statement. The ROI does not give a date for the invention described; the ROI does not bear the signature of the inventor Yokoyama; the RIO does not identify the invention by any reference number (that is, one of the RIO numbers noted by the inventor himself in the email dated 30 August 2006 to Counsel). Moreover, the title of the invention found on the ROI does not match the title of the application at issue. Finally, the copy of the ROI contains semi-legible lines, indicating that some of the boxes on the form have been

¹Regarding Item (5), Section 409.03(f) of the MPEP, **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

.....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

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² Counsel stated in the renewed petition filed on 24 May 2007: "I have firsthand knowledge that the invention described in 58821US006 was made by Chikafumi Yokoyama during his employment by Sumitomo 3M." This statement was insufficient as it was not supported by any facts based on her firsthand knowledge.

covered over or obscured before copying the ROI. This Record of Invention is insufficient to establish that Mr. Yokoyama invented the application at issue during his employment at Sumitomo 3M.

A statement of firsthand knowledge made from personal knowledge of the matter is required. A statement from a supervisor or co-worker of Mr. Yokoyama who has first hand knowledge that the invention was made during Mr. Yokoyama employment with the Japanese company Sumitomo 3M Limited would satisfy this requirement.

Furthermore, Petitioner has not provided a copy of the agreement between Sumitomo 3M Limited to 3M Innovative Properties Company, which gives the right to file the above identified application as the 37 CFR 1.47(b) applicant. The Acknowledgment of Patent Rights executed by Steven E. Skolnick, Chief Intellectual Property Counsel for Sumitomo 3M Limited is not sufficient to show the transfer of the right to file this application from Sumitomo 3M Limited to 3M Innovative Properties Company. 3M Innovative Properties Secretary Robert Sprague's statement under 37 CFR 3.73(b) does not fulfill this requirement. What is required is the agreement between Sumitomo 3M Limited and 3M Innovative Properties Company. A redacted copy of the confidential agreement between Sumitomo 3M Limited and 3M Innovative Properties Company or at least the relevant pages of these agreement should be submitted to support the statement and show that the right to file the above referenced application was transferred to the 37 CFR 1.47(b) applicant.

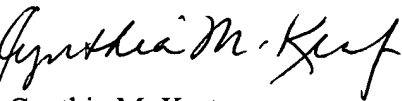
Accordingly, Item (5) above has not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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